

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants : Joel G. Hassell et al.
Application No. : 10/734,505 Confirmation No. : 1004
Filed : December 12, 2003
For : ELECTRONIC PROGRAM GUIDE WITH DIGITAL
STORAGE
Art Unit : 2421
Examiner : Omar S. Parra

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Commissioner for Patents
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New York, New York 10036
March 18, 2010

PRE-APPEAL-BRIEF REQUEST FOR REVIEW

Madam:

Applicants respectfully request review of the Office Action dated November 25, 2009. No amendments are being filed with this Request, which is being filed with a Notice of Appeal.

Concise Argument for Which Review is Being Requested begins on page 2 of this Pre-Appeal-Brief Request for Review.

CONCISE ARGUMENT FOR WHICH REVIEW IS BEING REQUESTED

Summary of Office Action

Claims 106-145 are pending in the above-identified patent application.

Claims 106-114, 116-124, 126-134 and 136-144 were rejected under 35 U.S.C. § 103(a) as being obvious from Schein et al. U.S. Patent Publication No. 2003/0196201 ("Schein") in view of Sampsell U.S. Patent No. 6,219,839 ("Sampsell").

Claims 115, 125, 135 and 145 were rejected under 35 U.S.C. § 103(a) as being obvious from Schein in view of Sampsell and in further view of Goldschmidt Iki et al. U.S. Patent No. 6,226,444 ("Goldschmidt").

Summary of Telephonic Interview

Applicants wish to thank the Examiner for the courtesy of the March 4, 2010 telephonic interview with the undersigned. Applicants respectfully submit that contrary to the information listed in the Interview Summary mailed March 10, 2010, the telephonic interview occurred on March 4, 2010 (not March 5, 2010). During the interview, the differences between the claimed invention and the cited references were discussed. Applicants respectfully submit that contrary to the Examiner's assertion in the Interview Summary, the undersigned did not agree with the Examiner's position during the interview.

Applicants' Claimed Invention

Applicants' invention, as defined by independent claims 106, 116, 126 and 136, is directed to providing a user with access to broadcast television programs and recorded programs stored on a digital storage device. Programs are recorded on the digital storage device, and a list of selectable options is provided to the user. The list includes a first selectable option that allows the user to access a list of selectable program listings having at least one selectable program listing for a broadcast television program and at least one selectable program listing for a recorded program stored on the digital storage device. The list also includes a second selectable option that allows the user to access a list of recorded programs stored on the digital storage device. A user selection of a recorded program from the list of selectable program listings is received, and the recorded program is played from the digital storage device in response.

Clear Error in the Rejection

In the Office Action, the Examiner admits that Schein does not disclose playing a recorded program in response to receiving a user selection of a recorded program from a list of selectable program listings. However, the Examiner relies on Sampsell to make up for this deficiency in Schein (*see* page 5 of the Office Action).

Sampsell refers to displaying descriptive information in a row within an electronic resource guide that is associated with a DVD (*see* presence row 102 in FIG. 9 of Sampsell). Sampsell also refers to providing on-screen controls for video stream functions as a user is viewing DVD programming (*see* controls 104 in FIG. 10 of Sampsell).

Although Sampsell displays descriptive information in a row associated with a DVD, Sampsell does not show or render obvious playing a recorded program in response to receiving a user selection of a listing from the row associated with the DVD (or from any other rows in the electronic resource guide). Moreover, even though Sampsell provides a pop-up grid with on-screen controls, Sampsell only provides the pop-up grid "[a]s the user views DVD programming" (*see* col. 7, lines 26-29 of Sampsell). From this express disclosure, it is clear that the viewer is not presented with the pop-up grid until after the user has already started viewing the DVD programming. Nowhere does Sampsell show or render obvious presenting the pop-up grid in response to receiving a user selection of a listing from the row associated with the DVD. Thus, Schein and Sampsell, whether taken alone or in combination, fail to show or render obvious "playing the recorded program from the digital storage device in response to receiving the user selection of the recorded program from the list of selectable program listings," as recited by independent claims 106, 116, 126 and 136.

Furthermore, Goldschmidt, which the Examiner uses in the rejection of other elements of applicants' dependent claims, does not make up for the deficiencies of Schein and Sampsell relative to the rejection.

For at least these reasons, applicants respectfully submit that independent claims 106, 116, 126 and 136 are allowable over the art of record. Since dependent claims 107-115, 117-125, 127-135 and 137-145 depend respectively from allowable independent claims 106, 116, 126 and 136, dependent claims 107-115, 117-125, 127-135 and 137-145 are also allowable over the art of record. Applicants therefore respectfully submit that the continued rejection of claims 106-145 is clear error.

Conclusion

For at least the reasons set forth above, applicants respectfully submit that claims 106-145 are patentable. Panel review of the rejections, and prompt allowance of this application, are respectfully requested.

Respectfully submitted,

/Baaba Andam/

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